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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,398	10/03/2003	Ralph Whitman	WHT.00001	3531

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EXAMINER	
LIPMAN, BERNARD	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
05/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/678,398	WHITMAN, RALPH	
	Examiner	Art Unit	
	Bernard Lipman	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2007*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *19-21* is/are allowed.

6)☒ Claim(s) *1-18,22 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly inserted limitation "wherein said at least one member does not function as a masking agent or fragrance" fails to find support in the specification. Applicant has argued that the term does, in fact, find support in the concepts presented in the specification even if the exact term is not found therein. This can be true. The case herein, however is that at least some of the oils required do contain fragrances that are sometimes desirable and do, therefore, “function as a fragrance”. The meaning of the phrase is unclear insofar as the question

of whether or not an additional fragrant substance would be required in order for the claimed oil not to act as a fragrance. There is not, therefore, sufficient support in the disclosure to define the scope of the added phrase.

Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "non-edible food grade" lacks support in the disclosure since food grade implies or at least can imply that it is edible and this is the only reference found in the disclosure for the concept. There is also no clear scope provided for the concept "non-edible".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-18, 22 and 23 as understood are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Neubauer or Barcelon or Wolfe alone or in combination.

Each of the references teaches lubricating compositions with various oils and other components, which may function as required by applicants' specification to meet the terms in the claims as defined by the specification. The compositions contain base oils, mineral oils and, in the case of Neubauer, are suited for the intended use of applicant's claims. Applicant's statement that no specific prima facie case of obviousness has been made has been considered but is not persuasive since this is not

the first time these references have been discussed in this application and the identity of specific components of the claims in the references has been effectively clarified. The intended use for the composition does not specifically define the claims except to the extent that the disclosed compositions of the prior art need to be able to function in that use. The chemical similarity of all the compositions in each of the references makes it a reasonable presumption that they could function in the intended use, In re Fitzgerald Et Al, 205 USPQ 594. The examiner has presented a reasonable presumption that the teaching of the reference is the same as the requirements of the claims. Under In re Fitzgerald practice, it is now incumbent upon Applicant(s) to present evidence of difference between the claims and the teaching of the reference in order to overcome the rejection. The claimed compositions, therefore, are either anticipated or rendered prima facie obvious to one of ordinary skill in the art in view of the broad and indefinite definitions in the specification of the terms used to define the claims.

Allowable Subject Matter

Claims 19-21 are allowable over the "closest" prior art Wolf (U.S. 6,039,937), Barcelon (U.S. 4,853,247), and Neubauer (U.S. 6,039,937) given that there is no disclosure or suggestion in Wolf, Barcelon, or Neubauer of composition comprising mineral oil, spearmint oil, peppermint oil, fish oil, emu oil, fatty acid, dye, fragrance, and anti-wear/non-corrosive additive (claim 19) or composition comprising mineral oil, spearmint oil, peppermint oil, emu oil, fatty acid, fragrance, and anti-wear/non-corrosive additive (claim 21).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Lipman whose telephone number is 571-272-1105. The examiner can normally be reached on 8-5 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bernard Lipman/
Primary Examiner
Art Unit 1796

BL/hs